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EXAMINER

FILIPCZYK, MARCIN R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,018	Applicant(s) HARNSBERGER ET AL.	
	Examiner Marc R. Filipczyk	Art Unit 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

This Action is responsive to Applicant's amendment filed on December 15, 2008, wherein claims 1-15 are pending.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the claim falls within one of the four statutory categories of invention recited in 35 U.S.C. § 101: process, machine, manufacture and composition of matter: The latter three define "things" or "products", while a "process" consists of a series of steps or acts to be performed. A process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform an article or physical object to a different state or thing. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

In the present case, independent claim 6 is a process claim. Claim 6 does not involve transformation of article or physical object to a different state or thing. Further, independent claim 1 does not tie into another statutory class such as a particular apparatus (i.e., computer comprising a physical processor).

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Therefore, claim 6, claims 7-10 which depend from claim 6, respectively, taken as a whole are directed to a mere method, i.e., to only its description, or an abstract idea, hence are non-statutory.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In the present case, claim 11 only recites a system but does not include any hardware to claim a physical system but instead is geared towards a program, and is rejected as program per se. A computer program is statutory while being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program.

Claim 11 does not execute any action.

Hence, claim 11 taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is descriptive material per se and hence is nonstatutory.

Since the claimed invention taken as a whole is not within the technological arts as explained above, claims 12-15 depend from claim 11 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefanescu et al (U.S. Publication No. 2003/0013951).

Regarding claims 1, 6 and 9, Stefanescu discloses a method and system for creating a medical reference book on a desired topic, comprising: (abstract)

entering medical reference information in an electronic authoring tool (figures 4-7), the electronic authoring tool including: (fig. 4, page 5, par. 50, lines 1-16)

a master outline authoring tool (figures 4-7), whereby an author is able to create a linkage between a diagnosis, an anatomical region, and a pathology; (par. 53, lines 1-6 and par. 56, lines 5-8)

a case authoring tool (figures 4-7), whereby the author is able to enter and edit images and text relating to a particular case; (par. 52, lines 6-12, par. 53, lines 1-6, par. 54, lines 13-23 and par. 56).

a diagnostic authoring tool (figures 4-7), whereby the author is able to create a comprehensive description of the diagnosis; (par. 55, lines 3-5)

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transferring the medical reference information into a relational content database (figs. 8 and 10, page 9, par. 83 and 84) wherein the medical reference information is stored as a series of reformattable data objects (par. 37 and 43) which are associated with data which describes each data object and its relationship to other data objects in the relational content database (fig. 10, par. 37, 43 and 56, and related text of fig. 10);

*(Note 1: limitations **above** teach building and using a medical database system)*

*(Note 2: limitations **below** teach searching and retrieving the desired material from the medical database system)*

selecting a desired topic about which the electronic clinical reference material is to be created; (pages 9, par. 89)

navigating the relational content database for medical reference information pertaining to the desired topic (page 10, par. 92 and 93) using the data associated with each data object in the relational content database which describes the data objects and their relationships (par. 53, lines 1-6 and par. 56, lines 5-8)

identifying data objects in the relational content database associated with medical data pertaining to the desired topic for inclusion in a medical reference book of a requested format (fig. 4-7, par. 53, lines 1-6 and par. 56, lines 5-8);

compiling the identified data objects into a medical reference book by reformatting the identified data objects in the content database into the requested format (par. 37, 43 and 93, also see fig 7 and 9); and

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generating the medical reference book on a desired topic in the requested format (page 10, par. 92 and 93), in addition, Stefanescu discloses product deployment (par. 37) and reformatting the data objects into education materials of a specified format (par. 37, 43 and 93)

Regarding claim 2, Stefanescu discloses reviewing the medical reference information prior to transferring it to the content database (fig. 8, item 824 and par. 92).

Regarding claims 3 and 4, Stefanescu discloses reference book is a printed and or electronic book (par. 93).

(Note: all electronic documents may be in printed)

Regarding claim 5, Stefanescu discloses a GUI (figs. 4-7 and par. 70).

Regarding claim 7, Stefanescu discloses providing imaging protocols (page 11, par. 99).

Regarding claim 8, Stefanescu discloses a continuing education system comprising performance and credits (figs 4 and 16, item 1634, also see *internet*).

Regarding claim 10, Stefanescu discloses database is searchable online (fig. 1 and col. 25).

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Regarding claims 11-15, they disclose limitations already addressed and rejected in the rejection above, in addition see fig. 2, items 200-206 of Stefanescu.

Response to Arguments

Applicant's arguments filed on 12/15/08 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Examiner notes that "medical reference information" is interpreted to mean helpful materials/content and "medical reference book" to mean either print or electronic publications.

Applicant argues that 101 rejections have been overcome.

Examiner disagrees. With regard to amended claim 6, the claimed reformatting of data does not include a processor, hence the rejection is maintained. With regard to claim 11, the process is not performed by the processor, hence the rejection is also maintained.

Applicant argues that the prior art does not teach automatic reformatting.

Examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (automatically process) are not recited in the rejected claim(s).

In addition, in paragraph 93, Stefanescu clearly teaches pre-processing of findings for review and dispatch. Preprocessing requires compilation of data. See the paragraph below for further explanation.

Applicant argues that the prior art does not teach linking data that can be reformatted.

Examiner disagrees. The claimed tools include an interface creating links between a diagnosis, anatomical region and pathology, entering data, diagnosing the data, all of which is taught by Stefanescu in paragraphs 53, 55 and 56. Note, Stefanescu's matching linkage is achieved by a matching button for matching reference text to images and clinical data used by the system, see paragraph 56. In addition, Stefanescu also teaches using different data formats such as JPEG, GIF, PDF, MP3, e.t.c. (par 37). The system formats the different data types for processing and interrelation. While the above mentioned tools for interrelating objects and labels are usually done with human assistance, the formatting of data can be done automatically by browsers and secondary programs (par. 37, 43 and 56). This data requires different applications and/or devices on user end for display and interaction (see fig. 4, 7, 9, 10, par. 37, 43, 56 and 93).

With respect to all the pending claims 1-15, Examiner respectfully traverses Applicants assertions based on the discussion and rejection cited above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents demonstrate the state of art with respect to medical systems.

U.S. Patent No. 6,263,330 of Bessette

U.S. Patent No. 6,757,898 of Ilsen et al.

U.S. Patent No. 6,850,944 of MacCall et al.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

March 17, 2009

/Marc R Filipczyk/

Examiner, Art Unit 2169

/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2169